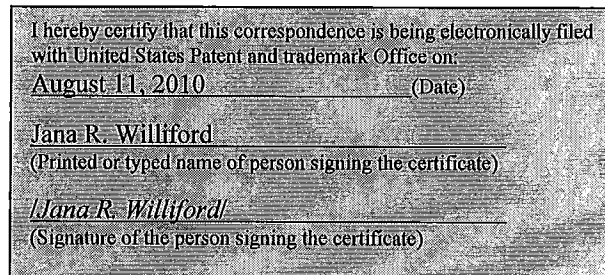


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michael J. Chambers, *et al.*
Serial No.: 10/665,607
Filed: September 19, 2003
Title: MOBILE TELEPHONE-BASED SYSTEM AND
METHOD FOR AUTOMATED DATA INPUT
Grp./A.U.: 2618
Examiner: Andrew Wendell
Confirmation No.: 6387

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450



Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Appellants have carefully considered this application in connection with the Final Examiner's Action electronically delivered May 11, 2010 (hereinafter "Office Action"). The Appellants respectfully request a pre-appeal brief review of this application in view of the following remarks.

REMARKS/ARGUMENTS

The Appellants originally submitted Claims 1-20 in the Application. Previously, Claims 6 and 16 were canceled without prejudice or disclaimer and Claims 21-22 were. Accordingly, Claims 1-5, 7-15 and 17-22 are currently pending in the Application.

I. Rejection of Claims 1, 4-5, 8, 11, 14-15, 18 and 21-22 under 35 U.S.C. §103

The Examiner has rejected Claims 1, 4-5, 8, 11, 14-15, 18 and 21-22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0087650 by Aarnio (hereinafter "Aarnio") in view of U.S. Patent No. 7,266,186 to Henderson (hereinafter "Henderson") and further in view of U.S. Patent No. 6,594,503 to Herzig, *et al.* (hereinafter "Herzig"). The Appellants disagree for at least the reasons given below.

Pending independent Claim 11 (and analogously independent Claim 1) recites:

A method of automated contact data input, comprising:
generating an image...in a first format that contains said contact data with a
mobile telephone having a camera;

...

storing said contact data in said second format in said specific contact
database of said mobile telephone... (Emphasis added.)

At item 2 on pages 2-3 of the Office Action, the Examiner asserts that portions of Aarnio teach these limitations. With regard to the limitation regarding generating an image that contains contact data, the Examiner states:

...location information is one form of contact data [sections 0006 and 0016] or even
retail information is another form of contact data [section 0023]...

The Appellants respectfully disagree that location information or retail information is a form of contact data.

One of ordinary skill in the art at the time of the invention would understand that contact data is data that pertains to a contact, or person, such as telephone number, address, e-mail address, or other information typically found on a business card. (*See, e.g.*, paragraphs [0003] and [0014] of the original specification.) Aarnio clearly is not concerned with contact data. Instead, Aarnio is

concerned with identifying a location from an image captured by a camera on a cell phone and providing information about an image captured by the camera on a cell phone. (*See, e.g.*, paragraphs [0006]-[0008] and [0016]-[0018] of Aarnio, cited by the Examiner.) As such, Aarnio does not teach or suggest generating an image in a first format that contains contact data as recited in pending independent Claims 1 and 11.

With regard to the limitation regarding storing contact data in a second format in a specific contact database of a mobile phone, the Examiner states:

...the contact is stored in the phone in order to for (*sic*) the user to view/hear the information, Sections 0006-0008 0016-0018, and 0023...

The cited portions of Aarnio teach that a Location Area Identity (LAI) of a cell/base station is used by a location server to obtain location information such as street maps, locations of buildings, landmarks, *etc.* The location information is transmitted back to a mobile station and can be in the form of a text message or diagram, or an audible message. Foreign language translations are possibly transmitted to the mobile station as well as retail information about retail establishments in the LAI. Thus, Aarnio teaches sending location information or retail information back to a cell phone. However, Aarnio does not teach or suggest that the location information or retail information is stored in specific contact database of a mobile phone as recited in independent Claims 1 and 11 since the location or retail information, as established above, is NOT contact data. Furthermore, the cited portions of Aarnio fail to teach or suggest that the location or retail information is stored in any specific database on the mobile telephone.

The Examiner recognizes that Aarnio fails to teach a user can easily make a call on the mobile telephone using extracted contact information and cites portions of Henderson cure these deficiencies of Aarnio. Furthermore, the Examiner recognizes that Aarnio and Henderson fail to teach a printed document. That is, Aarnio and Henderson do not teach scanning a printed document. To cure these deficiencies, the Examiner cites portions of Herzig. At the top of page 10 of the Office Action, the Examiner states that is reasonable to combine Herzig and Aarnio by simple substitution. The Appellants are unclear if the Examiner means to say it is reasonable to substitute the OCR reader of Herzig for the camera of Aarnio or that it is reasonable to add the OCR reader of Herzig to

Aarnio. However, one of ordinary skill in the art at the time of the invention would not be motivated to do either.

Replacing the camera of Aarnio with that of Herzig would, as established on page 3 of the response of February 12, 2010, render Aarnio unsatisfactory for its intended purpose. One of ordinary skill in the art at the time of the invention would not be motivated to add the OCR reader of Herzig to Aarnio since: (1) Aarnio is not concerned with reading printed documents (as the Examiner recognizes, *see above*); and (2) adding an OCR reader would add unnecessary cost and complexity to the mobile telephone of Aarnio, particularly given the cost sensitivities of cell phones.

For at least the reasons given above, the cited portions of the cited combination of Aarnio, Henderson, and Herzig, as applied by the Examiner do not provide a *prima facie* case of obviousness for pending independent Claims 1 and 11 and Claims that depend thereon. Accordingly, the Appellants respectfully request the Review Panel to remove the §103(a) rejections of Claims 1, 4-5, 8, 11, 14-15, 18 and 21-22 and allow issuance thereof.

II. Rejection of Claims 2-3, 7, 9-10, 12-13, 17, and 19-20 under 35 U.S.C. §103

The Examiner has rejected Claims 2-3, 7, 9-10, 12-13, 17, and 19-20 under 35 U.S.C. §103(a) as being unpatentable over Aarnio in view of Henderson and further in view of Herzig and further in view of: U.S. Patent No. 6,956,833 to Yukie, *et al.* (hereinafter "Yukie") for Claims 2, 7, 9, 12, 17, and 19; U.S. Patent Application Publication No. 2003/0211856 by Zilliacus (hereinafter "Zilliacus") for Claims 3 and 13; and U.S. Patent Application Publication No. 2003/0181200 by Iida (hereinafter "Iida") for Claims 10 and 20. The Appellants respectfully disagree.

As established above, the cited portions of the cited combination of Aarnio, Henderson, and Herzig, as applied by the Examiner, does not provide a *prima facie* case of obviousness for pending independent Claims 1 and 11 and Claims that depend thereon. Yukie, Zilliacus, and Iida have not been cited to cure the above-noted deficiencies of the cited portions of the cited combination of Aarnio, Henderson, and Herzig, but to teach the subject matter of the above-mentioned dependent claims. As such, pending independent Claim 1 and 11 and Claims that depend thereon are not obvious over Aarnio, Henderson, and Herzig alone, or in combination with Yukie, Zilliacus, or Iida.

Accordingly, the Appellants respectfully request the Review Panel to remove the §103(a) rejection of Claims 2-3, 7, 9-10, 12-13, 17, and 19-20 and allow issuance thereof.

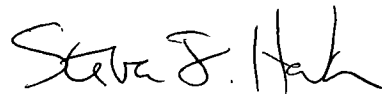
III. Conclusion

In view of the foregoing remarks, the Appellants see all of the Claims currently pending in this Application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1-5, 7-15 and 17-22.

The Appellants request the Reviewers to telephone the undersigned agent of record at (972) 480-8800 if such would further or expedite the prosecution of the present Application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

HITT GAINES, PC

A handwritten signature in black ink, appearing to read "Steven J. Hanke".

Steven J. Hanke
Registration No. 58,076

Dated: August 11, 2010

P.O. Box 832570
Richardson, Texas 75083
(972) 480-8800